

Claims 20-45 contain the subject matter of original claims 1-19, revised to more clearly define the instant invention, in order to address the rejections under 35 USC 112, first paragraph, and 35 USC 112, second paragraph, as further explained, below.

The Office action is not marked to reflect satisfaction of the requirements for claiming priority under 35 USC 119. Applicants request that the Examiner so mark the next Office action, i.e., by indicating in the section on the Office Action Summary page that §119 priority is claimed and the certified copy of the priority document was received by the PTO from the international bureau.

Claims were rejected under 35 U.S.C. 112, first paragraph, for alleged lack of enablement. Reconsideration is requested in view of the new claims submitted, hereby.

According to the statement of rejection, §112 enablement is not satisfied because the specification does not teach how to make the claimed beverage other than "in the form of a submicron emulsion or a microemulsion," (which is found in original claim 9 and in the specification at page 4, lines 22-23).

By the instant Amendment, all claims are limited to the beverage being "in the form of a submicron emulsion or a microemulsion," which is enabled under §112, ¶1, according to the statement of rejection. Therefore, the rejection under §112, ¶1, is overcome.

Claims were rejected under §112, second paragraph, for allegedly being indefinite. Reconsideration is requested in view of the changes to claim language effected by the instant Amendment, in conjunction with the following remarks.

By the instant Amendment, the following changes are realized: "characterized in that it comprises" (claims 1, 18) to --comprising--; "characterized in that it comprises" (claims 11, 14) to --further comprising--; "characterized in that it contains" (claim 8) to --further comprising--; "characterized in that" (claims 2-7, 9, 10, 13, 15-17) to --wherein--; "acceptable" (claim 1) to --acceptable as an additive--; "apparent solubility" (claim 1) to --visible solubility--; "antioxidant substances" (claim 11) to --antioxidant--. Other changes are realized by the instant claims; deleted "or derivatives thereof, especially lysolecithins" (claim 2) and added a dependent claim reciting --

wherein the lecithins are lysolecithins--; deleted "having in particular . . . 100 NTU" (claim 5) and included it in a new dependent claim; deleted narrower ranges (claims 6, 8, 18), and include them in new dependent claims; subject matter appearing between "brackets" (claim 15) is deleted and made the subject matter of new dependent claims; preferred divalent cations (claim 17), is deleted and made the subject matter of a new dependent claim; in claims containing "ethanol," the words "or nonalcoholic" are canceled from the claim preamble; language found in original claim 13 is changed to read ". . . said beverage becomes cloudy when an acidic liquid is added, thereto, by destabilization of the microemulsion."

With respect to the word "anethol," appearing in the claims (and specification), it need not be changed to --anethole--, as indicated in the statement of rejection. The word "anethol" is appropriately spelled (*The Online Cancer Dictionary*, downloaded page attached, hereto. The word "anethole" is merely a variant spelling (*Hackh's Chemical Dictionary*, page 45, copy attached, hereto).

Accordingly, applicants submit that the rejection under §112, ¶2, is in order for withdrawal.

The Examiner maintains the §103 (obviousness) rejection based on and includes claims 6-8 and 11-19 in the rejection.

Reconsideration is requested with respect to the rejection for alleged obviousness under 35 USC 103, based on U.S. 4,944,956 (Brun).

The instant claims are all limited to the subject matter of original claim 9; i.e., the instant claims are limited to a beverage "in the form of a submicron emulsion, or microemulsion." The Office action acknowledges that Brun, by itself, neither teaches nor suggests the subject matter of original claim 9, since claim 9 was not rejected based on Brun, by itself. Therefore, in accordance with the Office action, the present claims are not subject to rejection for obviousness under 35 USC 103 based on Brun, alone. Thus, withdrawal of the rejection is in order.

Original claim 9, and claim 10, were rejected under §103 for alleged obviousness based on the combined teachings of Brun and U.S. Patent No. 4,966,779 (Kirk). Reconsideration is requested.

According to the statement of rejection, Brun does not teach or suggest the beverage "in the form of a submicron emulsion, or microemulsion." However, the statement of rejection maintains that it would have been obvious to "micronize the emulsion of the prior art [Brun] in order to enhance the stabilization of the food product" (Office Action, page 7, lines 2-4 from the bottom of the page). Applicants submit that the statement of rejection is incorrect in making this allegation.

An emulsion with an average particle diameter of 0.5 to 8 microns has a cloudy aspect. On the other hand, a particle size of 0.1 micron, in accordance with the presently claimed invention, is required, i.e., in order for the beverage to have a clear aspect.

Moreover, Applicants submit it is not possible to obtain from the emulsion disclosed in Kirk a stable emulsion with smaller size particles only by high pressure homogenization, or by an appropriate mixture by high speed, such as defined in original claim 10 (represented by present claim 29). *W.J.*

Kirk discloses alcoholic beverages containing phospholipids with an HLB between 12 and 15 and with a miscell concentration (CMC) between  $10^{-1}$  and  $10^{-3}$  mmol/l. Consequently, even if a man skilled in the art would have desired to increase the apparent solubility of the anethol in the emulsion disclosed in Kirk, he would only replace one of the three surfactants disclosed in the reference by phospholipids disclosed in Brun; but, the skilled artisan would, certainly, not have replaced these surfactants by phospholipids with HLB comprised between 7 and 8, which is a requisite limitation on the presently claimed invention.

Moreover, according to the instant invention, phospholipids are present in a concentration from 1 to 30 g/l, which represents about 0.1 to 3% of the whole, whereas in the U.S. Patent No. 4,966,779 the modified lecithin only represents 0.5 to 10% weight.

When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). The "evidence upon which the examiner relies must clearly indicate that a worker of routine skill in this art would view the claimed invention as being obvious." *Ex parte*

*Wolters*, 214 USPQ 735, 736 (BPA&I 1982). As explained by the Board in the decision *Ex parte Levengood*, 28 USPQ2d 1300, 1300-01 (BPA&I 1993)(*emphasis in original*):

In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*,<sup>11</sup> preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention [*citations, omitted*].

An argument by the USPTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). When the

USPTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears *in the reference*. ... The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish inherency. ... [S]uch a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.

28 USPQ2c at 1557, *emphasis added*. "It is facts which must support the legal conclusion of obviousness. *Ex parte Crissy*, 201 USPQ 689, 695 (POBdApp 1976).

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because *it may doubt* that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

*In re Warner*, 154 USPQ 173, 178 (CCPA 1967) (*emphasis in original*). When the claimed invention requires modification of the prior art, there is no obviousness under §103 when "[t]he prior art does not suggest . . . modification of the . . . [prior art], or provide any reason or motivation to make the modification." *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989).

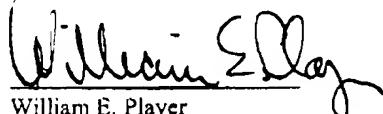
Applicants submit that, since the statement of rejection fails to provide the requisite evidence or scientific reasoning demonstrating how the skilled artisan would have considered obvious the combination of *all* limitations of the present claims, but relies instead on speculation and unfounded

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assumptions, the rejection under §103 based on the combined teachings of Brun and Kirk cannot be maintained.

Favorable action is requested.

Respectfully submitted,



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## anethol

<chemistry> A substance obtained from the volatile oils of anise, fennel, etc, in the form of soft shining scales.

Synonym: anise & amphor.

Origin: L. Anethum (see Anise) + -ol.

Source: Websters Dictionary

(01 Mar 1998)

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